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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,410	02/07/2002	Udo Bickers	514413-3911	1061
20999 7590 03/25/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAR 25 2009

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

In re Application of: :
Bickers et al. :
Serial No.: 10/049,410 : PETITION DECISION
Filed: February 7, 2002 :
Attorney Docket No.: 514413-3911 :

This is in response to the petition under 37 CFR § 1.181, filed March 18, 2009, requesting that the finality of the Office action of March 4, 2009 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on May 28, 2008 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 15, 17, 19, 20, 22, 24, 27 and 29-32 were pending and were examined on their merits. Although claims 14, 18, 21 and 23 were not listed on Form PTO-326, these claims were also pending and rejected. The examiner rejected claims 14, 15, 17-20, 22, 24, 27 and 29-32 under 35 U.S.C. § 103 (a) as being unpatentable over Narayanan et al. and rejected claims 14, 15, 17, 19, 20, 22, 24, 27 and 29-32 under 35 U.S.C. § 103 (a) as being unpatentable over Sanders. The examiner also rejected claims 14, 15, 17-20, 22, 24, 27 and 29-32 under 35 U.S.C. § 103 (a) as being unpatentable over Narayanan et al. in combination with Sprankle et al. The examiner further rejected claims 14, 15, 17, 19, 20, 22, 24, 27 and 29-32 under 35 U.S.C. § 103 (a) as being unpatentable over Sanders in combination with Sprankle et al. The examiner rejected claims 21, 23, 25, 26 and 28 under 35 U.S.C. § 103 (a) as being unpatentable over Lovejoy as applied to claims rejected using Narayanan or Sanders. The claims were also rejected on obviousness-type double patenting.

In reply to the non-final Office action of May 28, 2008, applicants filed a response on November 28, 2008. The response submitted by applicants included remarks and arguments traversing the rejections made in the non-final Office action. Additionally, applicants cancelled claims 1-32 and added new claims 33-58.

On March 4, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 33-58 were pending and were examined on their merits. The examiner rejected claims 33, 34, 37-43, 45-49, 52, 53, and 55-57 under 35 U.S.C. § 103 (a) as being unpatentable over Levitt et al. The examiner also rejected claims 33-38, 40, 42-52, 54 and 56-58 under 35 U.S.C. § 103 (a) as being unpatentable over Bieringer et al. The claims were also rejected on obviousness-type double patenting.

In response thereto, applicants filed this petition on March 18, 2009, requesting that the finality of the Office action of March 4, 2009 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on March 18, 2009, applicants request reconsideration of the final Office action mailed by the examiner on March 4, 2009 asserting that the final rejection was premature and improper. Specifically, applicants argue:

“The applicants' amendment did not necessitate the new grounds of rejection under 35 U.S.C. 103 because the result of the applicants' claim amendments served to narrow the scope of the claims under consideration and did not introduce new limitations which were not previously disclosed in the claims, i.e. the scope of the claims under examination were disclosed in the originally filed claims”.

Furthermore, applicants point out that “This application has been subject to numerous Office Actions and each of the references now cited were available as prior art since the first Office Action was sent in to the applicants on 22 May 2002 (the '594 patent was published on 16 May 2002). As such, there is no reason why the references (and rejections therefore) cited in the final rejection were not earlier presented, especially given the narrower scope of claims now pending and the fact that prior to the final rejection, the Examiner had submitted four (4) Form 892s”.

Applicants' arguments have been carefully considered. It is noted that the rejections set forth in the final Office action of March 4, 2009 of claims 33-58 under 35 USC 103 (a) were new rejections with new prior art considering that the examiner did not originally institute said rejection(s) in the non-final Office action. However, while new rejections are permitted in final Office actions, such new rejections are only proper under certain circumstances according to the provisions set forth in MPEP § 706.07 which states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the instant case, the new grounds of rejection of claims 33-58 presented by the examiner in the final Office action of March 4, 2009 were not necessitated by applicants' amendments to the claims on November 28, 2008 nor were the rejections necessitated by filing of an IDS. In fact,

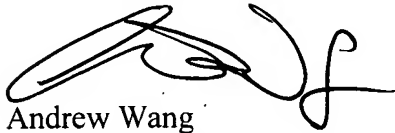
the newly presented claim limitations were in the original independent and dependent claims and should have been examined in the first office action. In view of the evidence, the final Office action issued March 4, 2009 is found premature and thus in error. Consequently, the finality of the Office action will be withdrawn in favor of applicants.

DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read 'Andrew Wang', with a stylized flourish at the end.

Andrew Wang
Acting Director, Technology Center 1600